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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,300	07/24/2000	Paul L. Hickman	HSC1P002.US01	7235
45965	7590	11/18/2010	EXAMINER	
TIPS GROUP c/o Intellevate LLC P. O. BOX 52050 Minneapolis, MN 55402			STORK, KYLE R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/625,300	Applicant(s) HICKMAN ET AL.	
	Examiner KYLE R. STORK	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,14-17,21-32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,14-17,31,32 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9.27.10</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is in response to the amendment filed 7 September 2010.
2. Claims 1, 14-17, 21-32, and 36 are pending. Claims 21-30 are withdrawn from consideration.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 27 September 2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 36 remains rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (US 6434580, filed 23 October 1998, hereafter Takano).

As per independent claim 36, Takano discloses a communications system comprising:

a client computer coupled to the Internet (Figure 15, item 200: Here, a client computer is used to file applications with the "Patent Office")

an applicant computer coupled to the Internet and communicating with the client computer (Figure 15, item 100: Here, the applicant, or inventor, enters information, stored at a server computer. The entered information is uploaded to the server, and is accessible by the applicant's representation for filing documents with the receiving agency)

an intermediary server coupled to the Internet communicating with the client computer, the client computer serving as an intermediary between the applicant computer and the intermediary computer (Figure 15, item 300: Here, the data input by the application, or inventor, is uploaded to the intermediary server. The client computer, being operated by the applicant's representation, allows the contents to be obtained from the server)

a recipient server coupled to the Internet and communicating with the intermediary server, the intermediary server serving as an interface between the client computer and the recipient server, whereby the recipient server communicates with the

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intermediary server as if the recipient server were communicating directly with the applicant computer (Figure 15, item 1000; claim 2)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Brown et al. (US 6671805, filed 17 June 1999, hereafter Brown).

As per independent claim 1, Takano discloses an automated electronic filing system comprising:

a web server coupled to the Internet (column 5, lines 45-51; Figure 15, item 300: Here, a server is connected to the Internet)

a receiving agency server separate from the web server and coupled to the Internet, such that it is capable of communication with the web server (Figure 15, items 300 and 1000: Here, the web server and the Patent Office, or receiving agency server, are coupled to the Internet)

a client machine separate from the web server and the receiving agency server and coupled to the Internet for communication with the web server, the client machine providing information to the web server forming at least a part of an electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer for the client machine, the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible (Figure 15; column 6, lines 5-15 and 44-59)

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the form includes at least one of a blank form and a partially filled-in form based upon information stored on the web server, wherein the form can be at least partially automatically filled-in in response to the selection (Figures 3 and 15; column 9, lines 11-35: Here, a template is downloaded. The template includes form fields, which are partially filled by reading a specification file)

Takano fails to specifically disclose:

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wherein communication between computers is authenticated and is at least partially encrypted

wherein the server provides the client with a form which can be verified by the server using heuristics

wherein the server automatically updates docketing information

wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client

Brown discloses:

authentication and encryption of communications between computers across a network (column 8, lines 23-34; column 9, lines 21-31)

wherein the server provides the client with a form which can be verified by the server using heuristics (column 8, lines 23-34; column 9, lines 21-31)

wherein the server automatically updates docketing information (column 21, lines 20-27)

wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client (Figure 8g; column 24, lines 11-43)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user ensure the integrity of legal documents.

As per dependent claim 14, Takano and Brown disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Takano discloses an applicant machine coupled to the Internet (Figure 15).

As per dependent claim 15, Takano and Brown disclose the limitations similar to those in claim 14, and the same rejection is incorporated herein. Takano further discloses wherein the applicant machine communicates with the web server the Internet (Figure 15).

As per dependent claim 16, Takano and Brown disclose the limitations similar to those in claim 15, and the same rejection is incorporated herein. Brown further discloses wherein communications between computers across a network are at least partially encrypted (column 9, lines 21-31). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user to security transmit information across a network.

As per dependent claim 17, Takano and Brown disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Brown further discloses wherein the communication between machines are subject to authentication (column 8, lines 23-34). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user to verify the sender of content.

9. Claims 31-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Daleen et al. (US 6493722, filed 13 April 1999, hereafter Daleen).

As per independent claim 31, Takano discloses an automated electronic filing system for use in electronic prosecution of trademark applications comprising:

a web server coupled to a wide area network (column 5, lines 45-51; Figure 15, item 300: Here, a server is connected to the Internet)

a receiving agency server separate from the web server and coupled to the wide area network such that it is capable of communicating with the web server, the receiving agency server associated with a governmental agency responsible for the administration of trademark registration (Figure 15, items 300 and 1000: Here, the web server and the Patent Office, or receiving agency server, are coupled to the Internet)

a client machine separate from the web server and the receiving agency server and coupled to the wide area network for communication with the web server, such that the web server serves as an interface to the receiving agency server, the client machine providing information to the web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, the electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer, the electronic document filed for further processing by the governmental agency in accordance with pre-established rules (Figure 15; column 6, lines 5-15 and 44-59)

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the web server provides the client machine with a form, wherein the form can be at least

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partially automatically filled-in in response to the selection (Figures 3 and 15; column 9, lines 11-35: Here, a template is downloaded. The template includes form fields, which are partially filled by reading a specification file)

wherein the web server serves as an interface between the client machine and the receiving agency server (claim 2)

Takano fails to specifically disclose wherein the server makes a payment on behalf of a client at a receiving agency. Daleen discloses wherein the server makes a payment on behalf of a client at a receiving agency (abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Takano, since it would have allowed a client to have his/her fees paid to a receiving agency.

As per independent claim 32, Takano discloses an automated electronic filing system comprising:

a web server capable of communicating over the Internet (column 5, lines 45-51; Figure 15, item 300)

a receiving agency server separate from the web server and capable of communicating over the Internet, the receiving agency server associated with a governmental agency (Figure 15, items 300 and 1000)

a client machine separate from the web server and the receiving agency server and capable of communicating over the Internet, such that the web server serves as an interface to the web server format at least a part of an electronic document, the electronic document to be filed with the receiving agency server by the web server for

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further processing by the governmental agency in accordance with pre-established rules, wherein the web server serves as an interface between the client machine and the receiving agency server, whereby the receiving agency server communicates with the web server as if the receiving agency server were communicating directly with the client machine (Figure 15; column 5, lines 5-15 and 44-59)

Takano fails to specifically disclose wherein the server makes a payment on behalf of a client at a receiving agency. Daleen discloses wherein the server makes a payment on behalf of a client at a receiving agency (abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Takano, since it would have allowed a client to have his/her fees paid to a receiving agency.

Response to Arguments

10. Applicant's arguments with respect to claims 1 and 14-17 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments with respect to claims 31-32 and 36 have been fully considered but they are not persuasive.

The applicant argues that the prior art of record fails to disclose an intermediary computer functionally located between a client computer and a receiving agency server (pages 10-11). The examiner respectfully disagrees. Takano discloses an intermediary server functionally located between a client computer and a receiving agency server

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(see claim 2). Here, the third computer is located between the inventor's client computer (Figure 15, item 100), and the receiving agency (Figure 15, item 1000). The third computer files the information received from the client with the receiving agency. For this reason, this argument is not persuasive.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle R Stork/
Primary Examiner, Art Unit 2178